

**REMARKS**

**I. STATUS OF CLAIMS**

Following entry of this amendment, claims 1, 4-60, 62, 63 and 65-69 are pending. Claims 2, 61 and 64 were previously canceled. Claim 3 has been cancelled, and the subject matter contained therein has been incorporated into independent claim 1. Claims 4, 5, 6 and 8 have been amended to change the dependency to claim 1 in view of the cancellation of claim 3. Claim 38 has been amended to recite that R is an alkyl radical. Support for this amendment can be found in the specification, for example, at page 7, lines 11-20. Accordingly, no new matter has been added by the amendments provided herein.

**II. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

The Examiner rejects claim 38 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner asserts that claim 38<sup>1</sup> recites general formulations for silicone resins, but does not define what groups R represents. See Office Action at page 2.

While Applicants do not agree with the Examiner's rejection, to advance prosecution, Applicants have amended claim 38 to recite that R is an alkyl radical. Thus, Applicants submit that claim 38 is clear and definite as amended and respectfully request that the Examiner reconsider and withdraw the rejection.

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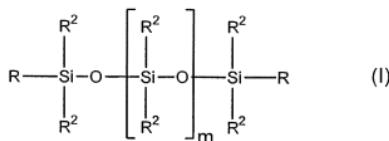
<sup>1</sup> In the Office Action, the Examiner stated that claim 37 is rejected; however, this is a typographical error as the general formulations for the silicone resins are recited in claim 38, not claim 37.

### III. REJECTION UNDER 35 U.S.C. § 102

The Examiner rejects claims 1, 3, 8, 10 and 11 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,126,136 to Merat et al. ("Merat"). The Examiner seems to assert that Examples 3, 5 and 7 in Merat, which disclose a process of making a water-proof lotion, meet all the limitations recited in the instant claims. See Office Action at 2. Applicants respectfully traverse the rejection for at least the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See M.P.E.P. 2131.

Independent claim 1, as amended, is directed to a process for reducing or eliminating the transfer or migration of a cosmetic, hygiene or pharmaceutical composition, said process comprising introducing into said composition an emulsion comprising at least one  $\alpha,\omega$ -substituted oxyalkylenated silicone of formula (I):



In formula (I), R is  $-(\text{CH}_2)_p\text{O}-(\text{C}_2\text{H}_4\text{O})_x(\text{C}_3\text{H}_6\text{O})_y\text{R}^1$ , and  $\text{R}^1$  is H,  $\text{CH}_3$  or  $\text{CH}_2\text{CH}_3$ .

In contrast, Merat discloses a lotion containing 1.0-4.0% dimethiconol poly[oxy(dimethylsilylene)],  $\alpha$ -hydro- $\omega$ -hydroxy as a film former and water proofing compound. See col. 2, lines 58-60. In the dimethiconol poly[oxy(dimethylsilylene)],  $\alpha$ -hydro- $\omega$ -hydroxy compound of Merat, the group at the position corresponding to "R<sup>1</sup>" in

Applicants' formula (I) is an -OH group, whereas, Applicants' claim limits that group to H, CH<sub>3</sub> or CH<sub>2</sub>CH<sub>3</sub>. Thus, the silicon resins of Applicants' claims differ from those of Merat and therefore, it is clear that Merat fails to teach or disclose each and every element of claims 1, 3, 8, 10 and 11.

In view of the foregoing, Applicants submit that Merat cannot and does not anticipate any of claims 1, 3, 8, 10 and 11. Reconsideration and withdrawal of the rejection is respectfully requested.

#### **IV. REJECTIONS UNDER 35 U.S.C. § 103**

##### **A. Rejection based on Nanba et al. in view of Merat et al.**

The Examiner has rejected claims 1, 3-19, 23-45, 48-52, 55-60, 62, 63 and 67-69 under 35 U.S.C. § 103(a) as allegedly being unpatentable based on U.S. Patent No. 6,063,391 to Nanba et al. in view of Merat.

In making a rejection under 35 U.S.C. § 103, the Examiner has the initial burden to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143. In its recent decision in *KSR Internat'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation ("TSM") test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a "rigid and mandatory" formula, the test can provide "helpful insight" to an obviousness inquiry. *Id.* Thus, even under that *Graham* analysis, the combined references must teach all the claim elements. See M.P.E.P. § 2143.

The Examiner asserts that Nanba discloses a method of making a transfer-free lipstick composition comprising a  $\alpha,\omega$ -substituted oxyalkylenated silicone as in Applicant's claimed invention. See Office Action at page 4. However, the Examiner acknowledges that Nanba does not specifically teach an emulsion comprising an  $\alpha,\omega$ -substituted oxyalkylenated silicone compound for producing a transfer-resistant effect. See *id.* In order to cure the deficiencies in Nanba, the Examiner turns to Merat. See *id.* Relying of Example 3 of Merat, the Examiner asserts that Merat discloses a process of making a lotion by incorporating a  $\alpha,\omega$ -substituted oxyalkylenated silicone, for example, dimethiconol poly[oxy(dimethylsilylene)],  $\alpha$ -hydro- $\omega$ -hydroxy, as a film former and water proofing compound in a water and oil emulsion. See *id.* Based on the teachings in Merat, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the present invention that the addition of the  $\alpha,\omega$ -substituted oxyalkylenated silicone of Merat in the process of making the lipstick in Nanba contributes to the staying power of the composition because Merat teaches that the  $\alpha,\omega$ -substituted oxyalkylenated silicone functions as a film former and water proofing compound. See *id.* Applicants respectfully traverse the rejection for at least the following reasons.

As the Examiner admits, Nanba fails to teach or suggest an emulsion comprising at least one  $\alpha,\omega$ -substituted oxyalkylenated silicone for reducing or eliminating the transfer or migration of a cosmetic, hygiene or pharmaceutical composition. Merat does not cure the deficiencies of Nanba. As discussed in Section III above, Merat does not teach the  $\alpha,\omega$ -substituted oxyalkylenated silicone of Applicants' formula (I) recited in Applicants' claimed invention. Accordingly, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness because neither Nanba nor Merat teach or suggest all the claimed limitations.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the § 103 rejection of claims 1, 3-19, 23-45, 48-52, 55-60, 62, 63 and 67-69 based on Nanba and Merat.

**B. Rejection based on Nanba et al. and Merat et al. further in view of Cosmetics Additives**

The Examiner has rejected claims 20-22 under 35 U.S.C. § 103(a) as allegedly being unpatentable based on Nanba and Merat as applied to claims 1, 3-19, 23-45, 48-52, 55-60, 62, 63 and 67-69 as discussed above, and further in view of Flick, E., Cosmetics Additives: An Industrial Guide, Noyes Publications, p. 70 (1991) ("Cosmetic Additives"). Applicants respectfully traverse the rejection for at least the following reasons.

A *prima facie* case of obviousness requires that the prior art references teach or suggest all the recitations of the claimed invention. M.P.E.P. § 2143. As discussed in Sections III and IV.A. above, the Examiner has failed to show that Nanba and/or Merat teach or suggest all the claimed limitations. Cosmetic Additives does not remedy the

deficiencies of Nanba and Merat. The Examiner merely relies on Cosmetic Additives for its teachings of particular dyes. See Office Action at page 5. Thus, the Examiner has failed to show that the cited references teach or suggest all the claimed elements and has thereby failed to establish that the claimed invention is *prima facie* obvious based on Nanba in view of Merat and further in view of Cosmetic Additives.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

**C. Rejection based on Arraudeau et al. in view of Merat et al.**

The Examiner has rejected claims 1, 12, 46, 47, 49, 53, 54, 65 and 66 under 35 U.S.C. § 103(a) as allegedly being unpatentable based on U.S. Patent No. 5,223,559 to Arraudeau et al. ("Arraudeau") in view of Merat. Applicants respectfully traverse the rejection for at least the following reasons.

As stated above, a *prima facie* case of obviousness requires that the prior art references teach or suggest all the recitations of the claimed invention. See M.P.E.P. § 2143. The Examiner asserts Arraudeau teaches all the elements of claimed invention except for an emulsion comprising at least one  $\alpha,\omega$ -substituted oxyalkylenated silicone for reducing or eliminating the transfer or migration of a cosmetic, hygiene or pharmaceutical composition. See Office Action at pages 5-6. The Examiner uses Merat to supplement the deficiencies of Arraudeau. However, as discussed in Sections III and IV.A. above, Merat does not teach the  $\alpha,\omega$ -substituted oxyalkylenated silicone of Applicants' formula (I). Accordingly, the Examiner has failed to establish that the claimed invention is *prima facie* obvious based on Arraudeau in view of Merat.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

**V. DOUBLE PATENTING**

The Examiner has provisionally rejected claims 1, 3-45, 48-60, 62, 63 and 65-69 under the judicially-created doctrine of obviousness-type double patenting over claims 1-4, 7-69, 76 and 77 of co-pending U.S. Application No. 10/366,371. Applicants note that U.S Application No. 10/366,371 has since issued as U.S. Patent No. 7,264,821 and that claims 38 and 39 were cancelled during prosecution. Thus, Applicants address this rejection based on the issued claims.

Applicants respectfully submit that the present invention is not obvious over the issued claims of U.S. Patent No. 7,264,821, and request that this rejection be held in abeyance until allowable claims are identified in the present application.

**VI. CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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